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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/455,651	12/07/1999	JURGEN ENGELBRECHT	452948-1	5435

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03/08/2002

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EXAMINER

MICHL, PAUL R

ART UNIT

PAPER NUMBER

1714

18

DATE MAILED: 03/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

TD-19

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-25 is/are pending in the application.
- ☐ Of the above claim(s) 16-22, 24, 25 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-15, 23 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit 1714

Claims 16-22, 24, and 25 stand withdrawn from consideration for being directed to the non-elected invention.

Claim 23 is rejected under 35 U.S.C. § 112 second paragraph. Claim 23 improperly depends upon claim 1. Claim 23 is a method claim. Claim 1 is not a method claim.

Claims 1-15 and 23 are rejected under 35 U.S.C. § 102(e) as being anticipated by Bryan and one of either Takahashi or Dunn and one of Ibsen '016 or Zalsman or Lee and one of either Jacobs or Oxman or Ibsen '489. The Examiner's position remains as stated in the December 6 Office action and June 13 Office action. Applicants' arguments have been considered but are not persuasive. Applicants argue that the Examiner's position is

"divorced from reality". This argument is not persuasive. Claim 1 is directed to two separate and distinct compositions. The first claimed composition is a partially resolvable polymer. The second claimed composition is an adhesive. A partially resolvable polymer lacks novelty. An adhesive lacks novelty. Therefore the claims lack novelty. There is no requirement within the claims that the polymer and the adhesive ever be admixed together or have any relationship together. It remains the Examiner's position that the recitation of "kit" is not a material limitation.

Claims 1-15 and 23 are rejected under 35 U.S.C. § 103 as being unpatentable over Brian and either Takahashi or Dunn and

Art Unit 1714


either Jacobs or Oxman or Ibsen '489 and either Ibsen '016 or Zalsman or Lee. The Examiner's position remains as stated in the December 6 and June 13 Office actions. A partially resolvable polymer would be obvious in these references. An adhesive would be obvious in these references. Therefore, the claims are obvious. The Examiner's previous comments concerning "kit" are also applicable to this rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Michl whose telephone number is (703) 308-2451. The examiner can normally be reached on Monday through Friday from 7:30 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for this Group is (703) 305-5433.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2351.

PRMichl:cdc
March 6, 2002


PAUL R. MICHL
PATENT EXAMINER
ART UNIT 156